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EXAMINER

HUI, SAN MING R

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/659,502
Filing Date: September 11, 2000
Appellant(s): NASSIF ET AL.

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EXAMINER'S ANSWER

This is in response to the appeal brief filed July 9, 2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

Upon reconsideration, the outstanding rejections under 35 USC 112 are withdrawn.

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows:

Issue No. 4 is incorrect. Only claim 3 is rejected under 35 USC 103(a) over Cheung et al. as set forth in the final office action mailed April 7, 2004.

(7) Grouping of Claims

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Appellant's brief includes a statement that claims 1-11, 13-21 and 26-28, and 31 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Examiner disagrees with the grouping proposed in the Brief. Claim 31 should stand or fall with claim 1 as claim 31 is not patentably distinct from claim 1. Claim 31 is more limited in scope than claim 1 but not patentably distinct from claim 1 since both claims recite the same "liquid composition comprising ..." (see line 5 of claim 31 and line 6 of claim 1). Since the claims are allowed to include any components in the composition, the two claims are considered not patentably distinct from each other.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,620,695	Elliott	4-1997
6,177,388	Cheung et al.	1-2001
6,045,813	Ferguson et al.	4-2000
6,022,839	Durbut et al.	2-2000

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-2, 4-21, 26-28, and 31 are rejected under 35 U.S.C. 102(e) over Cheung et al.

Cheung et al. disclose an aqueous concentrated liquid composition for cleaning hard surfaces which blooms when added to a larger volume of water, which comprises botanical oil constituents and a binary solvent system which includes at least one organic alcohol and glycol. Peppermint oil, lavender oil, bergamot oil, rosemary oil, and sweet orange oil are disclosed as botanical oils. Isopropyl alcohol is disclosed as an organic alcohol. Larger volumes of water can be added to the composition. See Cols. 14-16, claims 1, 2, 8 and 17. Table 1 of Col. 12 exemplifies a composition comprising 4% peppermint oil, 12% isopropyl alcohol (additional component to effect a household function), water (additional component to effect a household function), and other ingredients. Thus, Cheung et al. and the instant invention teach a method of applying a

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composition to an inanimate surface for household cleaning purposes, comprising 4% of an aromatherapeutic essential oil, and solvents selected from water or alcohol. It is respectfully pointed out that applying the composition to the surface results in providing aromatherapy to persons within the ambient environment. It is respectfully pointed out, regarding the recitation "allowing the aromatherapeutic essential oil to remain within the ambient environment to effect aromatherapy", that this limitation is met because the moment an essential oil is released from a container, the aroma begins to circulate within an area, thereby providing aromatherapy. Cheung et al. and the instant invention also teach a composition comprising at least 0.2% of antibacterial oil and a separate ingredient for effecting a household function.

Claim 21 is rejected under 35 U.S.C. 102(b) over Elliott.

Elliott exemplifies a composition comprising 96% carrier oil, 2% lavender (an antiseptic, an antiseptic which can effect a household function), 1 % eucalmtus (antibacterial essential oil), 1% ti tree. See Col. 2, lines 31-39. Thus, Elliott and the instant invention both teach a composition comprising at least 0.2% of an antibacterial essential oil (eucalyptus) and an ingredient that effects a household function (lavender).

The Examiner respectfully points out that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a

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manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Thus, the intended use of the instant composition claim is not given patentable weight.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 3 is rejected under 35 U.S.C. 103(a) over Cheung et al. as applied to claims 1-2, 4-2 1 and 26-28, 31 above.

The instant invention is directed toward a method for providing aromatherapy to persons or animals within an ambient environment comprising directly applying a composition consisting of a liquid composition to an inanimate surface to effect a household function selected from surface cleaning, surface shining, degreasing,

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cleansing, foreign matter removal, moisturizing, dish soaps, and iron liquids, the liquid composition comprising an aromatherapeutic concentration of an aromatherapeutic essential oil of 0.1-20%, completing the household function, allowing the aromatherapeutic essential oil to remain within the ambient environment to effect aromatherapy on persons or animals within the ambient environment the solvents in said liquid composition consisting essential of materials selected from water and alcohols; a composition comprising a liquid composition comprising 0.2% of an antibacterial essential oil and a separate ingredient that effects a household function.

Cheung et al. is applied as discussed above. The reference further teaches that the concentrate composition is particularly useful in the cleaning of surfaces composed of ceramics, glass, and metals. See Col. 11, line 64-Col. 12, line 17. The reference lacks an exemplification of cleaning these specific surfaces.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to exemplify a method of cleaning ceramic, glass or metal using the composition exemplified by Cheung et al. because Cheung et al. teach their compositions as particularly useful for cleaning ceramic, glass, and metal.

Claims 1-2, 4-20, 26-28, and 31 are rejected under 35 U.S.C. 103(a) over Ferguson et al.

Ferguson et al. teach lotions and gels with active ingredients in beads. Exemplified is a method of treating a surface with an active ingredient comprising providing a carrier liquid, disbursing in the carrier liquid a multiplicity of visible friable

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beads, each containing from about 0.5 to about 5% by weight active ingredient for treating the surface, dispensing the carrier with beads through a dispenser pump onto a surface; and using the carrier with beads on the surface, at least one of the steps of dispensing or the step of using the beads on the surface, causing fracturing of the beads to spill their contents and mix it with the carrier liquid. An essential fragrance oil is taught as the active ingredient. The composition is taught for use as a household cleanser. Alcohol and water are taught as carriers. Essential oils are taught as comprising 0.5-3% of the composition and chamomile extract is taught as an essential oil. Thus, both Applicant and Ferguson et al. disclose liquid cleaning compositions that are applied to hard surfaces, wherein the composition comprises aromatherapeutic essential oils and wherein aromatherapy is provided to persons within the ambient environment of the cleaned hard surface. The reference lacks an exemplification of effecting a household function. See Col. 1, line 5-Col. 2, line 65., Col. 8, line 57-Col. 12, line 64.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Ferguson et al. to exemplify a method of treating a surface for household cleansing with an 0.5-5% of an essential oil and carrier because Ferguson et al. specifically teach their method for household cleaning and because of the expectation of achieving a cleansing product that smells good. Regarding the limitation "allowing the aromatherapeutic essential oil to remain within the ambient environment to effect aromatherapy on persons or animals within the

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ambient environment", it is respectfully pointed out that this limitations is met because Ferguson et al. teach their methods as imparting fragrance upon cleaning.

It is respectfully pointed out that Ferguson et al. teach separate compositions for use on surfaces (ceramic, glass, metal. . .), since the compositions of Cheung et al. can contain varying amounts of ingredients.

Claim 3 is rejected under 35 U.S.C. 103(a) over Ferguson et al. in view of Durbut et al.

Ferguson et al. is applied as discussed above. The reference lacks preferred household functions.

Durbut et al. teach all-purpose liquid cleaning compositions comprising essential oils. The compositions are taught for cleaning hard surfaces such as painted woodwork, tiled walls, tile floors, bathtubs, and metal surfaces. See Col. 1, lines 10-67,. Col. 5, line 27-Co1. 6, line 9.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the household functions of Durbut et al., such as cleaning woodwork, tile, and metal surfaces, in the invention of Ferguson et al. because Ferguson et al. broadly teach their compositions for cleaning household surfaces and because of the expectation of achieving a product that can be formulated for multiple household tasks, thereby increasing the efficiency by which one cleans.

(11) Response to Argument

Appellant's arguments with regard to the rejections under 35 USC 112 is moot since the rejections are withdrawn.

Appellant's arguments with regard to the rejection under 35 USC 102 over Cheung et al. averring the instant claims excluding any solvents besides water and alcohol is not convincing. Examiner notes that the claims actually recites "a liquid composition comprising...". With the transitional phrase comprising recited, any additional components is permitted to be incorporated into the herein claimed liquid composition. Examiner further notes that the transitional phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps and those that do not materially affect the basic and novel characteristic of the claimed invention. But for the purpose of searching for and applying prior art under 35 USC 102 and 103, absent clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising". See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355. ("PPG could have defined the scope of the phrase consisting essentially of for purposes of its patent by making clear in its specification what it regarded as constituting a material change in the basic and novel characteristics of the invention."). When an applicant contends that additional steps or materials in the prior art are excluded by the recitation of "consisting essentially of," applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. *In re De Lajarte*, 337 F.2d 870, 143 USPQ 256 (CCPA 1964). See also *Ex parte Hoffman*, 12 USPQ2d 1061, 1063-64 (Bd. Pat. App. & Inter. 1989) ("Although consisting

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essentially of' is typically used and defined in the context of compositions of matter, we find nothing intrinsically wrong with the use of such language as a modifier of method steps. . . [rendering] the claim open only for the inclusion of steps which do not materially affect the basic and novel characteristics of the claimed method. To determine the steps included versus excluded the claim must be read in light of the specification. . . . [I]t is an appellant's burden to establish that a step practiced in a prior art method is excluded from his claims by 'consisting essentially of language.'" (See MPEP 2111.03). In the instant case, there is no clear indication in the specification or claims as to what the basic and novel characteristics actually are. Therefore, the instant claims are anticipated by Cheung et al.

Appellant's arguments with regard to claim 31 in which it excludes certain solvents is not convincing in view of the above. The herein claimed liquid composition does not exclude any components because it recites the transitional phrase "comprising".

Appellant's arguments with regard to the rejection under 35 USC 102 over Elliott averring Elliott's failure to teach the specific oil herein claimed are not convincing. Elliott clearly teaches essential oils (lavender and eucalyptus) to be incorporated into the composition. Therefore, claim 21 is anticipated by Elliott.

Appellant's arguments with regard to the rejection under 35 USC 103 over Cheung et al. towards claims 1-2, 4-21, 26-28 and 31 are not convincing and are believed to be misplaced. Only claim 3 is rejected over Cheung et al. in the rejection under 35 USC 103(a). The only limitation not expressly taught by Cheung et al. is the

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specific hard surfaces recited. Cheung et al. teaches the use of the composition therein for cleaning many hard surfaces including those claimed herein (See col. 11, lines 64 bridging col. 12, line 9). Therefore, possessing the teachings of Cheung et al. one of ordinary skill in the art would have been motivated to employ the Cheung's composition to clean the herein claimed hard surfaces.

Appellant's arguments with regard to the rejection under 35 USC 103 over Ferguson et al. averring Ferguson's failure to teach a direct applying method are not convincing. Examiner notes that it is not an anticipation rejection. The rejection set forth in page 8 states that Ferguson does not teach the herein claimed method of treating hard surface for household cleaning. However, it further states that it would have been obvious to one of ordinary skill in the art to employ the composition of Ferguson to treating the hard surface for household cleaning because Ferguson clearly teaches the composition therein as useful for household cleaning. Furthermore, the limitation "directly applying" is directed to the herein claimed liquid composition, not the active ingredients. The arguments appellant set forth in page 21 in the appeal brief is directed to the direct application of the active ingredients. Ferguson clearly suggests the employment of the composition therein to clean the herein hard surfaces by applying the composition for household cleaning purpose. Appellant's arguments are seen to be misplaced.

Appellant's arguments in page 21 in the appeal brief averring Ferguson's failure to teach the herein recited weight of essential oil is not convincing. Ferguson teaches the range of 0.5 to 5% of active (essential oils) in the beads can be used. The example

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Appellant cited of 0.1 % Chamomle extract is merely considered as an example, not the full range of the Ferguson's teachings. Furthermore, the weight ratio for the beads can be up to 2% if the liquid composition is lotion (See col. 4, lines 13). Therefore, the maximum weight percentage of essential oil contained in the whole composition would become 0.1%, which is within the range herein claimed.

Appellant's arguments averring the transitional phrase "consisting essentially of" and "consisting of" in the claims are not convincing in view of the same reasons discussed above. The liquid composition herein claimed does not exclude any other ingredients be incorporated into the same. Therefore, the claims are considered properly rejected over Ferguson.

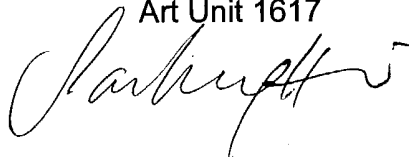
Appellant's arguments averring the rejection of claim 3 over Ferguson in view of Durbut not teaching the herein claimed composition because the instant claims are excluding the components taught in the prior arts are not convincing in view of the same reasons discussed above. The liquid composition herein claimed does not exclude any other ingredients be incorporated into the same. Therefore, the claims are considered properly rejected over Ferguson in view of Durbut.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

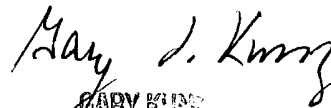
San-ming Hui
Primary Examiner
Art Unit 1617



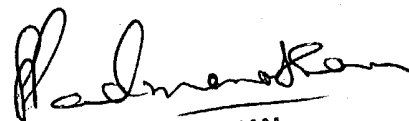
November 29, 2004

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